

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 28-54 were pending in this application when last examined and stand rejected. Claims 49-54 were withdrawn as non-elected subject matter.

Claims 28-54 were examined on the merits and stand rejected. Claim 47 was objected to.

Claims 28, 31, 32, 36, 37, 44, 46, and 47 have been amended in a non-narrowing manner to make minor editorial revisions to better conform to U.S. claim form and practice. Such revisions are non-substantive and not intended to narrow the scope of protection. Such revisions include: revising the claim language to provide proper antecedent basis throughout the claims, and revising the claims to use proper Markush language. Claim 46 is amended to change its dependency 41 to provide proper antecedent basis for the recited terminology. Support can be found in the claims as filed and throughout the general disclosure.

The specification is amended to include appropriate section headings to conform to U.S. practice.

No new matter has been added by the above amendments.

Applicants note that the above claim amendments are intended to address matters of form only as they are not intended to affect the scope of the claims. Accordingly, if the next Office Action on the merits includes a new ground of rejection of one or more claims, the Action must be non-final.

II. FOREIGN PRIORITY CLAIM

On page 3 of the Action, the Office indicated that the effective US filing date of the claimed invention is September 30, 2004, the filing date of the PCT application PCT/FR04/02480. This position is respectfully traversed.

Generally, to establish foreign priority, it is sufficient to submit a claim for priority along with a certified copy of the foreign application. See 37 C.F.R. § 1.55(a)(1)-(2) and M.P.E.P. § 201.14(a)-(b). Certified "translations" of the priority documents are only required to establish priority to overcome a prior art rejection over intervening art. See 37 C.F.R. § 1.55(a)(4) and M.P.E.P. § 201.14(a).

In this regard, the Office cites JANSEN (US 2004/0071716; filed 2/20/2002) as intervening prior art. See the obviousness rejections over JANSEN. However, Applicants respectfully traverse the obviousness rejections over JANSEN for the reasons noted below. Thus, it is believed that JANSEN is not intervening prior art.

The Office has acknowledged receipt of a certified copy of the priority document, French application no. 0311952, filed October 13, 2003.

For these reasons, it is respectfully submitted that the requirements to establish foreign priority have been met and thus, Applicants should be entitled to the foreign priority date of October 13, 2003, i.e., the filing date of French application no. 0311952.

Therefore, kindly acknowledge such in the next Office Action.

III. CLAIM OBJECTION

Claim 47 was objected to for containing a minor informality for the reasons noted on page 3 of the Office Action.

The present amendment overcomes this objection by amending the claim to correct noted informality. Withdrawal of the objection is requested.

IV. OBVIOUSNESS REJECTIONS

Claims 28-33 and 36-48 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over JANSEN (US 2004/0071716; filed 2/20/2002) in view of WESTESEN (US 6,207,178; issued 3/27/2001) for the reasons on pages 4-7 of the Office Action.

Claims 28, 34, and 35 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over JANSEN in view of WESTESEN and RABUSSIÉ (US 3,258,326; issued 6/28/1966) for the reasons on page 8 of the Office Action.

These rejections are respectfully traversed and will be discussed together below as JANSEN and WESTESEN are used in each rejection as the primary and secondary references, respectively.

The rejections should fall, because the cited prior art references fail to teach, suggest or make obvious all of the limitations of claim 28 (i.e., the sole independent claim), as required to support a *prima facie* case of obviousness.

Claim 28 recites: "[A] composition comprising: a monodisperse lipid phase dispersed in a continuous aqueous phase, in which the lipid phase comprises: at least one crystallizable lipid, at least one active principle, and at least one compound stabilizing the dispersed phase, said at least one stabilizing compound comprising two fatty acid chains and one polyethylene glycol chain."

None of the cited references disclose or suggest each and every element of claim 28, namely adding a crystallizable lipid (solid) to an emulsion. Indeed, it is respectfully submitted that the combined teachings of JANSEN in view of WESTESEN and/or RABUSSIÉ would not have led one skilled in the art, at the time the invention was made, to produce the claimed combination product for the reasons set forth below.

Based on the teachings in JANSEN, it is believed that JANSEN actually teaches away from adding a crystallizable lipid (i.e., a solid) to an emulsion as required in claim 28.

It is well established that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2141.02, VI. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2145, X, D, 1. Further, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.01, V. Likewise, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.01, VI.

In this case, the objective in JANSEN is provide emulsions presenting a low viscosity. Indeed, JANSEN provides

emulsions having a very low viscosity and suitable for injection (see [0011] and [0049]). However, based on this objective in JANSEN, one skilled in the art would not be induced to add a crystallizable lipid (i.e. a solid) as used in WESTESEN to an emulsion according to JANSEN, because adding a solid to the emulsion would automatically lead to an increase of viscosity, what would be exactly the opposite of the objective of JANSEN.

Moreover, WESTESEN teaches that suspensions of solid lipids are not equivalent to lipid emulsions. The physicochemical properties of lipid suspensions differ substantially from those of lipid emulsions and that lipid suspensions cannot be prepared and treated analogously to lipid emulsions (col. 13, lines 1-61 to col. 14, line 1).

Knowing this, the skilled person is therefore aware that the teaching of JANSEN is not transposable to obtain a suspension of solid particles. Also, the fact that the lipid phase of JANSEN (comprising a liquid lipid) is monodisperse does not absolutely imply that this lipid phase, wherein the liquid lipid would be substituted by a solid lipid, would be monodisperse too.

Along these lines, please note that the crystallizable lipid according to the invention is defined as a solid lipid, the melting point of which is from 30° to 95°C (page 7 line 37 to page 8, line 1 of the present application).

Consequently, the skilled artisan would not have been lead to combine the teaching of JANSEN and WESTESEN to arrive at the claimed composition. Thus, the compositions of claim 28 and all claims dependent thereon are believed to be novel and non-obvious over the combined teachings of JANSEN and WESTESEN.

As to the second obviousness rejection, the Office argues that the subject matter of claims 28, 34 and 35 is obvious over the teachings of the two aforementioned documents combined with RABUSSIER. Applicants respectfully disagree.

RABUSSIER discloses anti-parasitic compositions comprising a solid phase containing solid and hydrophobic particles of a pesticidally active ingredient in a suspension in a continuous aqueous medium. The compositions according to RABUSSIER comprise a hydrophilic polysaccharide colloid, as an alginate.

However, please note that the skilled person would not have been lead to combine the teaching of JANSEN, WESTESEN and RABUSSIER to achieve the claimed invention for the same reasons noted above. In this regard, RABUSSIER fails to rectify the teaching away in JANSEN. Also, the teaching of RABUSSIER is distinct from the one of the invention as; (1) the lipid phase of RABUSSIER is not monodisperse as required in claim 28; and (2) the emulsions according to RABUSSIER do not contain a solid lipid as required in claim 28.

Thus, the skilled person wishing to prepare a composition comprising a monodisperse lipid phase containing a solid lipid would clearly not consider RABUSSIÉ. The skilled person is not induced either to combine the teaching of RABUSSIÉ with JANSEN and WESTESEN.

Furthermore, RABUSSIÉ does not disclose suspensions comprising the combination of a stabilizing compound comprising two fatty acid chains and one polyethylene glycol chain and of a lipid. RABUSSIÉ, therefore, does not teach the means to obtain the composition of claims 28, 34, and 35.

In view of the above, it is respectfully submitted that the claimed composition is novel and non-obvious over the combined cited references.

At most, RABUSSIÉ teaches adding an alginate to compositions comprising a lipid. However, as the composition according to claim 28 is not obvious for the reasons noted above, the compositions according, to claims 34 and 35, which are drawn to specific embodiments wherein the composition further comprises a thickener, are also not obvious.

Thus, it is believed that the composition of claim 28 is novel and patentable over JANSEN, WESTESEN, and RABUSSIÉ, alone or when combined, because the cited references fail to disclose each and every element of the claims, and the references in fact, teach away from the claims.

Withdrawal of the obviousness rejections is respectfully requested.

V. CONCLUSION

Having addressed all the outstanding issues, the amendment is believed to be fully responsive. In view of the above, it is respectfully submitted that the application is in condition for allowance and notice to that effect is hereby requested. If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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